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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VIDOVICH, GREGORY M

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 01/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/682,594

Applicant(s)
Preston et al.

Examiner
Gregory Vidovich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 25, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Sep 25, 2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-20, drawn to a movable storage surface, classified in class 224, subclass 310.

II. Claims 21-23, drawn to collapsible rails, classified in class 224, subclass 326.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as use without collapsible rails and invention II has separate utility such as an integrated roof rack which is collapsed to reduce wind noise.. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. John Artz on December 27, 2001 a provisional election was made with traverse to prosecute the invention of invention I, claimed 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-

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23 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Drawings

6. The drawings are objected to because:

- a) it is unclear as to how track elements 36 travel along guide elements 38; applicant provides no structure in the written description or drawings as to how this is remotely performed;
- b) it is unclear as to how rails 26 are collapsible in light of applicant providing no structure in the written description or drawings as to how this is performed. Correction is required.

Specification

7. The disclosure is objected to because of the following informalities:

- a) it is unclear as to how rails 26 are collapsible;

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b) in figure 2, absent a guide element associated with the left side of the surface or the track element indicated as lead line 36 in figure 2, it is unclear as to how the surface may properly move between the respective positions as disclosed;

c) it is unclear as to how track elements 36 travel along guide elements 38; applicant provides no structure in the written description or drawings as to how this is remotely performed;

d) in paragraph 19 at line 3, only two mounting elements are illustrated.

Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 3 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 3 and 13, as discussed above, applicant provides no details in the application as to how the rails are collapsible and therefor is subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention.

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10. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a storage surface moveable between first and second positions by means attached between the vehicle and the surface, does not reasonably provide enablement for merely the surface being moveable absent any structure to allow this feature to perform. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Although applicant is entitled to provide broad claims, the claims are limited in breadth by the written description. At least applicant's claim 1 simply reads on a box moved from the top of the vehicle to the side of a vehicle manually by a person. Obviously, this is well outside applicant's disclosed invention.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, in light of the unreasonable breadth of the claim provided by applicant, it is unclear as to what applicant truly regards as the invention. One having ordinary skill in the art would not understand the scope and coverage of applicant's claim and one would have to clearly speculate as to what is intended as the claimed invention. The unreasonable breadth of this claim renders the claims dependent therefrom indefinite since the piecemeal attempt by applicant to

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broadly construe the invention renders the ordinary artisan to clearly speculate as to what is intended in the claimed limitation therefor rendering it indefinite. Again, applicant is entitled to provide broad claims. However, when the claims provided are of such unreasonable breadth such that when an operable device not remotely set forth by the claims must be speculated by the ordinary artisan to construct the claimed invention which is operable, the claims will be clearly deemed indefinite.

13. If applicant continues to prosecute the application, revision of the drawings, specification, and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, **no subject matter can be added that was not disclosed in the application as originally filed.**

Claim Rejections - 35 U.S.C. § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States; and (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

15. Claims 1, 4-11, and 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Haselgrove.

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Regarding claim 1, Haselgrove discloses a storage surface (28) movable as claimed (see figures 1 and 2).

Regarding claim 4, Haselgrove includes a track (see proximate lead line 32 in figure 3) and a guide (20) as claimed.

Regarding claim 5, the track element includes a securing slot therein which engages the guide.

Regarding claim 6, see figures 1 and 2.

Regarding claim 7, see lead lines 42 on the far right and far left of figure 1 which indicate end rail elements attached to the respective surfaces.

Regarding claim 8, see lead lines 42.

Regarding claim 9, see lead line 20.

Regarding claim 10, see lead lines 50 and 54.

Regarding claim 14, the track elements includes a plurality of slots (one slot engages the guide element and the other slot allows the pin 50 to pass therethrough).

16. Claims 1, 2, 4, and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al.

Regarding claim 1, the Kim reference discloses a storage surface (see lead line 24) as claimed (see figures 1 and 2).

Regarding claim 2, see proximate lead lines 30-33.

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Regarding claim 4, see proximate lead line 74 to the right in figure 1 which a track and proximate lead line 92) which is a guide.

Regarding claim 8, see lead lines 60 and 62.

Regarding claim 9, see lead line 80.

Regarding claim 10, see proximate lead lines 100 and 102 or proximate lead lines 26 and 28.

Claim Rejections - 35 U.S.C. § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haselgrove in view of Kim et al.

Regarding claim 2, although the surface in Haselgrove is not locked in the second position, attention is directed to the Kim reference which discloses this well known feature as discussed above. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a locking mechanism to lock the surface(s) in Haselgrove in the second position to secure the device when in the second position from unintentional shifting.

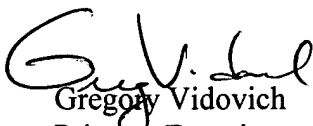
19. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haselgrove in view of Jansson or Parkins.

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Regarding claim 3, although the Haselgrove reference does not disclose collapsible rails, attention is directed to the Jansson reference which discloses collapsible rails (2, 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide collapsible rails on the roof in Haselgrove as, for example, illustrated in Jansson in order to fully utilize the free space thereon to maximize the carrying capacity of the vehicle roof. Alternative, attention is directed to the Parkins references which discloses collapsible rails (24, 25) to maximize the carrying capacity of the surface (2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the carrying surface in Haselgrove to have collapsible rails as, for example, illustrated in Parkins in order to increase the carrying capacity thereof.

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Spanke, Ernst (2), Hori, and Geay references each disclose a roof rack.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Vidovich whose telephone number is (703) 308-1513.


Gregory Vidovich
Primary Examiner
Art Unit 3727
January 10, 2002